

REMARKS

Claims 14-24 and 33-41 are pending in the present application.

This Amendment is in response to the Office Action mailed February 21, 2008. In the Office Action, the Examiner rejected claims 14-24 and 33-41 under 35 U.S.C. §103(a). Applicant has added claims 42-43 and amended claims 14 and 41. Applicant submits that the newly-added claims introduce no new matter. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 14-24 and 33-41 under 35 U.S.C. §103(a) as being unpatentable over Applicant's Admitted Prior Art ("APA") in view of U.S. Patent No. 5,886,145 issued to Harari et al. ("Harari"). Applicant respectfully traverses the rejection and submits that the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP §2143, p. 2100-126 to 2100-130 (8th Ed., Rev. 5, August 2006)*. Applicant respectfully submits that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

Furthermore, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated: "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined." *MPEP 2141*. In *KSR International Co. vs. Teleflex, Inc.*, 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that "[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge

possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” The Court further required that an explicit analysis for this reason must be made. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR 127 S.Ct.* at 1741, quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). In the instant case, Applicant respectfully submits that there are significant differences between the cited references and the claimed invention and there is no apparent reason to combine the known elements in the manner as claimed, and thus no *prima facie* case of obviousness has been established.

Harari, taken alone or in combination with APA, does not disclose or render obvious at least one of: (1) an adapter being different than the card having a first form factor and configured for insertion into the slot and for receipt of a card having a second form factor different than the first form factor, and (2) the adapter to use out of band (OOB) signals to send a serial transport stream to the card having the second form factor, as recited in claim 14.

Harari merely discloses mother card portion 10 being a PCMCIA form-factor PC card with the standard 68-pin connector 12 on one side and a native interface connector 14 on the other side (Harari, col. 6, lines 63-67), not an adapter being different than the card having a first form factor and configured for insertion into the slot and for receipt of a card having a second form factor different than the first form factor, as recited in claim 14. *Emphasis Added.* The mother card 10 is removably connected to the host system 200 and the daughter card 20 has an edge connector 24 directly plugging into the mother card 10 (Harari, col. 7, lines 1-6). The Examiner alleges that the mother card 10 is equivalent to both the adapter and the card having the first form factor (Office Action, page 3). In contrast, in the present invention, the adapter is different from the card having a first form factor. To clarify this aspect of the invention, claim 14 has been amended accordingly. Thus, since the mother card 10 cannot be both the adapter and the card having a first form factor, Harari fails to disclose this element of claim 14.

Similarly, with respect to claim 33, the mother card 10 cannot be both the means for enabling the conditional access module to communicate with a first card having a first form factor as well as the first card having a first form factor because the claim delineates that the

means and the first card are separate. In addition, with respect to claim 41, the mother card 10 cannot be both the first card having a first form factor and an adapter since the claim delineates that the slot is sized to receive the first card or the adapter such that the first card and the adapter are separate.

Moreover, Harari merely discloses the daughter card 20 having an edge connector 24 directly plugging into the mother card 10 by mating with the native interface connector 14 (typically less than 68 pins) (Harari, col. 6, line 63 to col. 7, line 6), not the adapter to use out of band (OOB) signals to send a serial transport stream to the card having the second form factor, as recited in claim 14. The daughter card's native interface connector 24 generally has pins that include connections to ground, voltage supplies, serial data in and/or out, timing, control lines, select lines, address and register lines, test pins as well as a signal that acknowledges the presence of a daughter card. In a minimum pin implementation, data, addresses and commands are multiplexed into a serial stream before being passed across the native interface 12, 24. Once across, the serial stream is demultiplexed into their respective components (Harari, col. 11, line 63 to col. 12, line 8). There is no teaching, express or inherent, of the mother card 10 using OOB signals to send a serial stream to the daughter card. Thus, the mother card 10 cannot be equivalent to the adapter, as alleged by the Examiner.

Therefore, Applicant believes that independent claims 14, 33, and 41 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §103(a) be withdrawn.

Conclusion

Applicant respectfully requests timely examination of the subject application. If the Examiner has any questions concerning the allowability of the pending claims, he is invited to contact the undersigned attorney at the phone number listed below. Such discussions may facilitate prosecution of the subject application.

Respectfully submitted,
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